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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,685	03/09/2000	David P. Maher	112770	1985

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EXAMINER

HAYES, JOHN W

ART UNIT PAPER NUMBER

3621

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary****Application No.**

09/521,685

**Applicant(s)**

MAHER, DAVID P.

**Examiner**

John W Hayes

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-53 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44-53 and 57-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to the claims have been considered but are either not persuasive or moot in view of the new ground(s) of rejection.
2. Applicant argues that the present invention is distinguished from the Asay et al reference since, in the present invention, the guarantor makes payment to the supplier without having received or given any assurances to the supplier relative to the certificate. Examiner respectfully disagrees and notes that Asay et al disclose that the supplier may request assurance for the transaction, however, Asay et al also disclose that it is within the supplier's (relying party) discretion to carry out the transaction without any further investigation relative to the certificate or the guarantor's guarantee to make the payment or requesting further assurance (Col. 11, lines 45-55; Col. 17, lines 5-16; Col. 17 line 65-Col. 18 line 7; Col. 32, lines 65-67; Col. 38 line 50-Col. 39 line 34).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 44-47, 49, 57 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asay et al, U.S. Patent No. 5,903,882 in view of Fox et al, U.S. Patent No. 5,790,677.

As per **Claim 44**, Asay et al disclose a method performed by a guarantor of payment for purchases comprising:

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- receiving a request to send to a user at least one short-term certificate, the request containing at least information that verifies the identity of the user (Col. 5, lines 2-5; Col. 10, lines 27-36; Col. 11, lines 56-62);
- responsive to the request, and upon authenticating the user, determining a maximum amount and a period of time during which said guarantor is willing to provide payment for purchases by the user (Col. 5, lines 29-38; Col. 8, lines 9-12; Col. 13, lines 60-65);
- sending to the user a short term certificate guaranteeing payment up to said maximum amount for a purchase by the user from a supplier in a transaction carried out over a network, so that use user is enabled to enter into a transaction using the short term certificate as a form of payment that will be accepted by the supplier, the short term certificate including expiration information corresponding to the period of time (Col. 5, lines 2-5; Col. 8, lines 9-12; Col. 10, lines 37-40; Col. 11, lines 10-15 and 44-61; Col. 13, lines 60-65; Col. 14, lines 54-60; Col. 39, lines 1-27);
- receiving that short-term certificate and an electronic record of the transaction from the supplier (Col. 8, lines 27-38; Col. 16, lines 20-36; Col. 32, lines 20-30).

Asay et al disclose guaranteeing payment to the supplier through the use of a primary certificate which would ultimately involve sending the payment to the supplier, however, fails to explicitly disclose this. Asay et al disclose that the supplier may request assurance for the transaction, however, Asay et al also disclose that it is within the supplier's (relying party) discretion to carry out the transaction without any further investigation relative to the certificate or the guarantor's guarantee to make the payment or requesting further assurance (Col. 11, lines 45-55; Col. 17, lines 5-16; Col. 17 line 65-Col. 18 line 7; Col. 32, lines 65-67; Col. 38 line 50-Col. 39 line 34). Fox et al disclose generating and sending credentials to consumers to be used during a transaction (Col. 11, lines 14-25; Col. 23, lines 10-55) and further disclose that the purchaser creates a commerce document such as a purchase order (Col. 12, lines 50-57) and a commerce instrument such as a purchase instruction identifying a method of payment (Col. 25, lines 3-13) including the purchaser's credential in order to initiate a transaction. The merchant then verifies the purchaser's credential and forwards the payment instruction to an acquirer server in order to receive payment for the transaction (Col. 25, lines 44-67; Col. 26, lines 13-23). Fox et al also disclose that the

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merchant carries out the transaction without requesting assurance relative to the purchaser's credentials or relative to the guarantor's guarantee to make the payment. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Asay et al and include a step of making a payment to the supplier for the purchase as taught by Fox et al. This would have been a typical step carried out in any transaction in order to complete that transaction and forward payment to the supplier for goods and services provided. It further would have been obvious to carry out the transaction and provide payment to the supplier without having received from the supplier any request for assurance relative to the certificate and without providing any assurance to the supplier as suggested by both Asay et al and Fox et al.

As per **Claims 45-46**, Asay et al fail to explicitly disclose billing the user for the purchase through a regular billing channel between the guarantor and the user, however, this is disclosed by Fox et al (Col. 26, lines 13-22). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Asay et al and provide for a method for ultimately billing the purchaser for the goods purchased as taught by Fox et al. This would have been a typical step carried out in any transaction in order to complete the transaction and bill the user for the goods purchased through conventional channels.

As per **Claim 47**, Asay et al further disclose wherein the short term certificate further includes an assertion of at least one entitlement of the user in addition to the ability to use the short term certificate to pay for purchases (Figure 11; Col. 5, lines 29-39; Col. 11, lines 10-15).

As per **Claim 49**, Asay et al further disclose wherein the short term certificate further includes an indication that the user is entitled to use a form of payment other than money such as a letter of credit (Col. 19, lines 1-17).

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As per Claims 57 and 60, Asay et al disclose a method performed by a supplier of goods or services comprising:

- receiving short-term certificate from a customer that contains a maximum amount and information indicative of a period of time during which the guarantor is willing to guarantee payment for purchases by the customer (Col. 5, lines 7-14 and 35-38; Col. 8, lines 12-15; Col. 10, lines 37-43; Col. 11, lines 43-50; Col. 16, lines 20-39; Col. 17, lines 5-12);
- consummating a purchase transaction with the customer over a network including acceptance of the short term certificate as payment for the purchase (Col. 17, lines 5-37; Col. 38, lines 50-55; Col. 39, lines 1-27);

Asay et al, however, fail to explicitly disclose sending the certificate and an electronic record of the transaction to a billing system for payment from the guarantor and receiving the payment. Asay et al disclose guaranteeing payment to the supplier through the use of a primary certificate which would ultimately involve sending the payment to the supplier, however, fails to explicitly disclose this. Asay et al disclose that the supplier may request assurance for the transaction, however, Asay et al also disclose that it is within the supplier's (relying party) discretion to carry out the transaction without any further investigation relative to the certificate or the guarantor's guarantee to make the payment or requesting further assurance (Col. 11, lines 45-55; Col. 17, lines 5-16; Col. 17 line 65-Col. 18 line 7; Col. 32, lines 65-67; Col. 38 line 50-Col. 39 line 34). Fox et al disclose generating and sending credentials to consumers to be used during a transaction (Col. 11, lines 14-25; Col. 23, lines 10-55) and further disclose that the purchaser creates a commerce document such as a purchase order (Col. 12, lines 50-57) and a commerce instrument such as a purchase instruction identifying a method of payment (Col. 25, lines 3-13) including the purchaser's credential in order to initiate a transaction. The merchant then verifies the purchaser's credential and forwards the payment instruction to an acquirer server in order to receive payment for the transaction (Col. 25, lines 44-67; Col. 26, lines 13-23). Fox et al also disclose that the merchant carries out the transaction without requesting assurance relative to the purchaser's credentials or relative to the guarantor's guarantee to make the payment. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the method of Asay et al and include a

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step of making a payment to the supplier for the purchase as taught by Fox et al. This would have been a typical step carried out in any transaction in order to complete that transaction and forward payment to the supplier for goods and services provided. It further would have been obvious to carry out the transaction and provide payment to the supplier without having received from the supplier any request for assurance relative to the certificate and without providing any assurance to the supplier as suggested by both Asay et al and Fox et al.

5. Claims 48, 50-53 and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asay et al, U.S. Patent No. 5,903,882 and Fox et al, U.S. Patent No. 5,790,677 and applied above and further in view of Golden et al, U.S. Patent No. 5,761,648.

As per Claims 48, 50-53 and 58-59, Asay et al fail to explicitly disclose wherein the short term certificate contains information specifying consumer points, consumer marketing offers or purchase discounts. Golden et al disclose an interactive marketing network and process using electronic certificates and teach issuing electronic certificates to users that can be used for various purposes and include specifying coupons, discounted prices on a product or service, proof of a gift or award such as loyalty points, proof of payment or any other type of certificate or voucher (abstract, Col. 8, lines 10-18). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Asay et al and Fox et al and allow for the specification of certain points, marketing offers or discounts in the certificate as taught by Golden et al. Golden et al provides motivation for providing these discounts in a certificate by indicating that this provides added efficiencies to companies merchandising products and services online (Col. 1, lines 10-63).

### **Conclusion**

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

8. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sudia discloses a method for securely using digital signatures in a commercial cryptographic system and further teach a user long term basic certificate as well as a short term authorization certificate that specifies transaction amount limitations and time limits.
- Fox et al [US 2002/0069174] disclose a system for electronic commerce transactions and further teach sending a customer certificate to a bank for payment
- Walker et al disclose a method for executing cryptographically enabled letters of credit



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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

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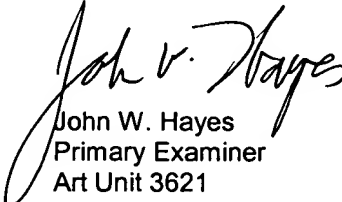
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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

  
John W. Hayes  
Primary Examiner  
Art Unit 3621

September 6, 2004